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| 09/913,339 | 01/16/2002 | Jose Duez | 28944/37661 | 8636 |

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EXAMINER

PRUNNER, KATHLEEN J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3751 | |

3751

DATE MAILED: 07/18/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|------------------------------------|--|
| Application No. 09/913,339 | Applicant(s) DUEZ ET AL. | |
| Examiner Kathleen J. Prunner | Art Unit 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 June 2003.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-45 is/are pending in the application.
4a) Of the above claim(s) 40 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 19-39 and 41-45 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 January 2002 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) Interview Summary (PTO-413) Paper No(s). _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other:

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DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "2" has been used to designate three different elements, i.e., a body (note Fig. 1 and line 16 on page 9), an aerosol can (note Fig. 2 and line 24 on page 9), and a non-aerosol can (note Fig. 5a and lines 1 and 3 on page 10). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "3" has been used to designate both a reservoir (note Fig. 1 and line 17 on page 9) and a deformable internal bag (note Fig. 5a and line 3 on page 10). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign **mentioned** in the description: **6** (note lines 19 and 20 on page 9). A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
4. The drawings are objected to because the figure designations include a period at the end, e.g., "Fig. 1."; this period should be deleted. A proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. Applicant is required to submit a proposed drawing correction **in reply to this Office action** in order to avoid abandonment of the application. Any proposal by the applicant for amendment of

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the drawing to cure defects **MUST** be embodied in a **SEPARATE LETTER to the Draftsman**. See MPEP §608.02(r). The objection to the drawings will not be held in abeyance.

6. Applicant is required to submit a proposed drawing correction in response to this Office action. Any proposal by applicant for amendment of the drawings to cure defects must consist of two parts:

- a) A separate letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in red ink in accordance with MPEP § 608.02(v).

IMPORTANT NOTE: The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner, but the print or pen-and-ink sketch with proposed corrections shown in red ink is required in response to this Office action, and may not be deferred.

Specification

7. The following informalities in the specification are noted: (A) on page 4, line 12, "it" should read --the backing--; (B) on page 6, line 5, "defined in the present Application," should read --is--; (C) on page 6, line 6, the comma should be changed to read --and--; (D) on line 20 of page 7 and on line 19 of page 8, a comma should be inserted after "i.e."; (E) on page 9, line 14, "valve" should read --application head--; and (F) on page 10, line 6, a comma should be inserted after "i.e.". Appropriate correction is required.

8. The following informalities in the Abstract are noted: (A) on line 2, "A" should read --An application--, "for applying" should read --uses bristles to apply--, a period should be inserted directly after "products", "is disclosed" should be deleted, and "may" should be deleted; (B) on line 3, "include" should read --includes--, and "comprising" should read --provided with the--; and

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(C) on line 5, a period should be inserted directly after “head”, “with the” should read --The--, “being of a predetermined” should read --have a--, and --less than 20 mm and preferably not less than 5 mm-- should be inserted after “length” and before the period.

9. The following informalities in the claims are noted: (A) in claim 19, on line 6, --bristles have a-- should be inserted after “wherein the”, and “of the bristles is” should be deleted; (B) in claim 25, “organized in a” should read --resulting from an association of-- (note lines 12-13 on page 4), “a” (second occurrence) should be deleted, and --threads-- should be inserted after “warp”; (C) in claim 40, on line 1, “the” (fourth occurrence) should be deleted; (D) in claim 40, on line 2, “form a single” should read --one-- (note line 26 on page 7); (E) in claim 41, on line 1, --the body and the body is-- should be inserted after “fixed to”; (F) in claim 43, on line 1, --the body and the body is-- should be inserted after “fixed to”; and (G) in claim 43, on line 2, --the reservoir in the form of-- should be inserted after “comprising”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the bristles to be fixed to the backing by “any appropriate means, for example by weaving, bonding, flocking or ultrasound” (note lines 13-15 on page 5), does not reasonably provide enablement for the bristles to be fixed to the backing by “means selected from the group consisting of weaving, bonding, flocking, ultrasound or analogous means”, as called for by claim 26. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

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12. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the backing to be made of “polyester or of polyester reinforced with an elastomer” (note lines 9-11 on page 4), does not reasonably provide enablement for the backing to be made of “polyester reinforced with elastomer or analogous material”, as called for by claim 28. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

13. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “the outside edge of the base is rounded” (note lines 17-18 on page 6), does not reasonably provide enablement for “the base has a rounded outer edge”, as called for by claim 32. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

14. Claims 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the bristles to have a density “between approximately 30 bristles/cm² and approximately 500 bristles/cm², preferably between approximately 50 bristles/cm² and approximately 200 bristles/cm², and more preferably still between approximately 90 bristles/cm² and approximately 110 bristles/cm²” (note lines 17-23 on page 5), does not reasonably provide enablement for the bristles to have a density “between approximately 30 bristles/cm² and approximately 200 bristles/cm²”, as called for by claim 37. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim.

15.- The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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16. Claims 31, 32 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 31 contains a term lacking proper antecedent basis. The claim recites the limitation "the backing" in line 1. There is insufficient antecedent basis for this limitation in the claim.

18. Regarding claim 31, the phrase "having at least one orifice" renders the claim indefinite because it is unclear how this "at least one orifice" structurally relates to the "at least one orifice" recited in claim 19.

19. Claim 45 contains a term lacking proper antecedent basis. The claim recites the limitation "the valve" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 19-23, 29, 31-39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret ('143). Baumann et al. disclose a device for applying a product such as cosmetics or shaving cream (note lines 62-66 in col. 2) having the claimed features including a body (constituted by the container structure of sleeve member 1) including a reservoir constituted by inner compartment 6 (note lines 58-63 in col. 2), an application head (constituted by applicator element 8 and cover member 7) having the bristles of a brush (note lines 70-74 in col. 2) fixed on the support formed by cover member 7 having an orifice or material discharge opening 15,

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the application head being adaptable to the body 1 (note Fig. 1), and means for conveying the product from the reservoir 6 to the application head constituted by the piston member 2 and the threaded spindle 3. Although Baumann et al. disclose that a small brush can be used as the applicator element 8 (note lines 71-74 in col. 2) but fails to describe the length of the bristles forming such a brush, attention is directed to Gueret ('143) who discloses another product applying device using an application head formed by brush bristles having a length ranging from 8 to 40 mm and preferably from 11 to 20 mm (note lines 5-10 in col. 3) in order to provide an applicator which allows the product to be applied rapidly while at the same time conveying much more product than a conventional brush such that it is possible to deposit a layer thickness greater than with a conventional brush (note lines 43-49 in col. 1). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the bristles of Baumann et al. having a length ranging from 8 to 20 mm in view of the teachings of Gueret in order to provide an applicator which allows the product to be applied rapidly while at the same time conveying much more product than a conventional brush such that it is possible to deposit a layer thickness greater than with a conventional brush. With respect to claim 20, Gueret further teaches the obviousness of using a bristle length less than 15 mm (note lines 5-10 in col. 3). With respect to claim 21, Gueret also teaches the obviousness of using a bristle length of not more than 10 mm (note lines 5-10 in col. 3). With regard to claim 22, Gueret additionally teaches the obviousness of using a bristle length that is not less than 5 mm (note lines 5-10 in col. 3). With regard to claim 23, the support formed by cover member 7 in Baumann et al. inherently forms a backing. With respect to claim 29, Gueret further teaches the obviousness of forming the brush bristles of synthetic materials or natural materials (note lines 11-20 in col. 3). With respect to claim 31, Baumann et al. also discloses that the bristles are fixed to at least a portion of the central surface of a base formed by cover member 7 (note Figs. 3, 5 and 7) and that the base 7 is adaptable to the body 1 of the device and has at least

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one orifice 15. With regard to claim 32, Baumann et al. further disclose that the base 7 has a rounded outer edge (note Fig. 7). With regard to claim 33, Gueret also teaches the obviousness of using a bristle diameter between approximately 15 μm and 60 μm , i.e., approximately 15/100th of a mm and approximately 60/100th of a mm (note lines 13-15 in col. 3). With respect to claim 34, Gueret additionally teaches the obviousness of using a bristle diameter between approximately 20 μm and 40 μm , i.e., approximately 20/100th of a mm and approximately 40/100th of a mm (note lines 39-41 in col. 3). With respect to claim 35, Gueret further teaches using a bristle diameter between approximately 35 μm and 40 μm , i.e., approximately 35/100th of a mm and approximately 40/100th of a mm (note lines 39-41 in col. 3). With respect to claims 36-38, although Baumann et al. fail to describe the specific density of bristles used in forming the brush applicator, nonetheless, to select a density within the claimed range would be considered mere routine experimentation to the artisan skilled in the brush applicator art determined solely by the particular material from which the bristles are made, the particular product being dispensed as well as by the particular type of coverage to be made to the applied surface and would simply be the result of optimization of the prior art teachings through routine experimentation, which is not a matter of invention, absent a showing to the contrary (see *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955), *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969), and MPEP § 2144.05). With regard to claim 39, Baumann et al. further disclose a foaming cream product, such as shoe cream or shaving cream (note lines 58-67 in col. 2). With regard to claim 41, Baumann et al. also disclose that the application head is fixed to a non-aerosol container structure or can. With regard to claim 42, Baumann et al. additionally disclose that the body 1 is integrated with the reservoir 6 (note lines 62-63 in col. 2).

22. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41 and 42 above, and further in view of

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Goncalves. It is considered that the orifice 15 in Baumann et al. constitutes a slit type of opening. Although Baumann et al. fail to disclose the materials forming the applicator head, attention is directed to Goncalves who discloses another brush type applicator in which the applicator is made of flexible plastic material which is rigid and elastically deformable (note lines 8-10 in col. 2) so that it is of simple construction and adaptable for all kinds of containers (note lines 47-49 in col. 1). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the brush applicator head of Baumann et al. of flexible plastic material which is rigid and elastically deformable in view of the teachings of Goncalves in order to form an applicator head that is of simple construction and adaptable for all kinds of containers.

23. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41 and 42 above, and further in view of Barber, Jr. With respect to claims 25 and 27, although Baumann et al. fail to disclose the specific material forming the backing support of the brush applicator, attention is directed to Barber, Jr. who discloses another brush applicator having a backing (note from line 65 in col. 16 to line 33 in col. 17) formed by a network, i.e, a woven fabric, of polyester threads organized in or having an association with a weft and warp (note lines 13-19 and 29-30 in col. 17) in order to form a backing which is flexible and exhibits substantial conformability to whatever surface it is being applied to (note lines 13-16 in col. 17). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the backing support of Baumann et al. by a network, i.e., a woven fabric, of polyester threads having a weft and warp in view of the teachings of Barber, Jr. in order to form a backing which is flexible and exhibits substantial conformability, when in use, to whatever surface it is being applied to. With regard to claim 26, although Baumann et al. fail to disclose how the brush bristles are attached to the support backing, attention is directed to Barber, Jr. who discloses another brush applicator having the bristles attached or fixed to a

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backing by weaving or bonding (note lines 29-32 in col. 17). It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the brush of Baumann et al. by weaving or bonding in view of the teachings of Barber, Jr. in order to form a flexible, supple brush that is easily conformable, when in use, to whatever surface it is being applied to. With regard to claim 28, although Baumann et al. fail to disclose the specific material forming the backing support of the brush applicator, attention is directed to Barber, Jr. who discloses another brush applicator having a backing (note from line 65 in col. 16 to line 33 in col. 17) formed by polyester reinforced with elastomer (note lines 13-23 in col. 17) in order to form a backing which is flexible and exhibits substantial conformability, when in use, to whatever surface it is being applied to.

24. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41 and 42 above, and further in view of Donsky. Although Baumann et al. fail to disclose from what specific material the bristles of the brush applicator are formed, attention is directed to Donsky who discloses another brush applicator in which the bristles are formed of mohair. It would have been obvious to one of ordinary skill in the brush applicator art, at the time the invention was made, to form the bristles of Baumann et al. from mohair in view of the teachings of Donsky in order to provide a brush made of natural origin to comply with ecological conservation concerns.

25. Claims 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumann et al. in view of Gueret as applied to claims 19-23, 29, 31-39, 41 and 42 above, and further in view of Webster. Baumann et al. further disclose that the shaving product container structure 1 is a piston operated reservoir device. Although Baumann et al. fail to disclose that the shaving product container structure 1 can be formed with a flexible and deformable bag reservoir which is surrounded by propellant gas, attention is directed to Webster who discloses another shaving product container

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structure (note lines 28-30 in col. 7) in which the container structure is a pressurized container or can having a flexible and deformable bag (note lines 35-38 in col. 1 and 34-36 in col. 2) which is surrounded by propellant gas (note lines 44-51 in col. 6) and that uses a valve in order to dispense the product in controlled amounts (note lines 5-11 in col. 1) when a non-foamy gel shaving product is to be dispensed (note lines 32-37 in col. 1). It would have been obvious to one of ordinary skill in the applicator art, at the time the invention was made, to form the shaving product container structure of Baumann et al. as a can or container formed with a reservoir defined by a flexible and deformable bag surrounded by propellant gas in view of the teachings of Webster in order to dispense a non-foamy gel shaving product in controlled amounts. With respect to claim 44, although Webster fails to describe the specific gas used for the propellant gas, to use compressed air as the propellant gas is considered to be obvious to one of ordinary skill in the applicator art especially when complying with or taking into account the environmental and ecological concerns regarding the ozone layer and atmospheric conditions. With regard to claim 45, Baumann et al. further disclose that the application head is fixed to the container; Webster further teaches the obviousness of using a valve 16 of ring or annular shape (note Fig. 1 and lines 6-9 in col. 4).

Election/Restriction

26. Claim 40 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Conclusion

27. The Examiner is advising attorneys to FAX any response due to Office actions. The U. S. Patent and Trademark Office (USPTO) is experiencing major delays in matching up papers that were

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mailed. Due to the Anthrax issue, any mail sent to the USPTO is automatically sent to an irradiation center in Virginia. It has been found that the irradiation process makes papers too brittle to handle. Therefore, the irradiation center has to further copy each paper. The originally filed irradiated papers are then placed in a sealed envelope and put in the associated file. After this irradiation process, the "papers" are then sent to the Office where they are matched with the file. This entire procedure causes months in delays due to the quantity of mailed received. Therefore, it is suggested that any response be sent by FAX especially if a time limit is critical. The FAX number for the technical center where this file is located is given in the paragraph below.

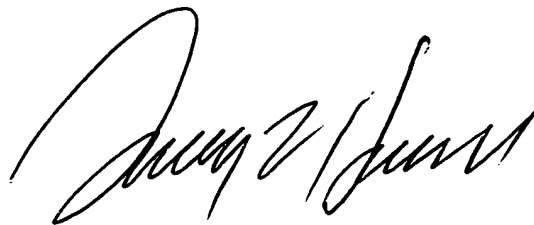
28. Any inquiry concerning this communication from the examiner should be directed to Examiner Kathleen J. Prunner whose telephone number is 703-306-9044. The examiner can usually be reached Monday through Friday from 5:30 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Huson, can be reached on 703-308-2580. The FAX phone number for the organization where this application is assigned is 703-308-7766.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0861.


Kathleen J. Prunner:kjp

July 14, 2003



7-14-03
GREGORY L. HUSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700